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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,086	06/12/2000	Richard Marc Libman	23651.0536	6844

3528 7590 11/19/2002

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n N .

09/592,086

Applicant(s)

LIBMAN, RICHARD MARC

Examiner

Raquel Alvarez

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-- The MAILING DATE f this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-128 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-128 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11,12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

1. This communication is in response to communication filed on 8/28/20002.

Claims 2-128 have been added.

#### **Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. With respect to independent claims 1 and 64, the claims are non-statutory subject matter because the claims are not in the "technological" or "useful" arts, and the claims do not affect or define the technology. See *In re Toma*, 197 USPQ 852 (CCPA 1978).

#### **Information Disclosure Statement**

3. The information disclosure statement filed 8/29/2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Reference AR 7 by Dottie Enrico, "Dollars and Dialers: Phone company's plan to sell names stirs controversy" has not been considered.

#### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-30 32-93 and 95-127 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munsil et al. (5,761,650, hereinafter Munsil) in view of Ryan (5,673,402 hereinafter Ryan).

With respect to claims 1-30, 32-93 and 95-127, Munsil teaches a method for automatically preparing a client communication pertaining to a product for a client (see figures). Producing a format for the client communication wherein the communication format includes a variable portion (i.e. the bill contains an allocated space for inserts)(see figure 6); inputting into a computer-accessible storage medium variable information other than the client identification (i.e. messages are defined and stored in a computer's memory)(see figure 7); inputting into the storage medium decision information (i.e. criteria for defining and including messages and inserts in the bill are stored)(see figure 7); using the decision information to select a subset of the variable information for inclusion in a variable portion of the client communication corresponding to the variable portion of the client communication format ( see figure 7); and generating the client communication according to the communication format, the generating step including inserting the subset of variable information into the variable portion of the client communication corresponding to the variable portion of the client communication format(i.e. the qualified message is inserted into the bill according to the formatting rules that fit into the bill)(see figures 7).

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Munsil does not specifically teach that the client communication pertains to a financial product. The billing system and method of Munsil pertains to a cable television providers. Ryan teaches that the communication pertains to a financial product (in Munsil (Figures 27B and 29-31). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the communication to be for financial products and services because it would provide the information needed to tailor the additional products to the client's needs (in Ryan, col. 5, lines 17-22).

With respect to claims 31 and 94, the claims further recite selectively placing at least some content in blank spaces of said communication. Official notice is taken that it old and well known to selectively place blank spaces in a communication. For example, certain text books contained blank spaces that are used for future modification or changes. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included selectively placing at least some content in blank spaces of said communication in order to achieve the above mentioned advantages.

### **Conclusion**

**5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:**

**A.** Anonymous, "Phone Company finds Direct Mail is most Efficient Seller of Service" teaches targeting advertisements based on the content of a telephone bill.

**Response to Amendm nt**

6. The terminal disclaimer was received and it overcame the double patenting rejection.

The affidavit filed on 8/28/2002 under 37 CFR 1.131 has been considered but is ineffective to overcome the Munsil reference. Where the conception occurs prior to the date of the reference, but reduction to practice is afterwards, it is not enough merely to allege that patent owner or applicant had been diligent. Ex parte Hunter, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence. An applicant must account for the entire period during which diligence is required. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); In re Harry, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964)(statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. (Diligence requires that applicants must be specific as to dates and facts.). **In this case the applicant must show evidence of facts to establish diligence from 12/2/95-6/10/96.**

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**Point of contact**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

R.A.  
November 15, 2002

*Steve Gravini for [unclear]*

STEPHEN GRAVINI  
PRIMARY EXAMINER